

REMARKS

Claims 9 and 35 have been amended to correct a minor typographical error, and no substantive amendments have been made to the claims. No new matter has been added. Applicant respectfully submits that pending claims 9-43 are in condition for allowance.

Priority Document

The Office Action (at page 2) acknowledged Applicant's claim for foreign priority to Denmark applications but noted that Applicant did not file a certified copy of the applications. Applicant respectfully disagrees, for certified copies of the priority documents were timely filed with the International Bureau before entering the U.S. national stage. (*See* June 28, 2006 Notification for PCT application no. PCT/DK2006/000195.) Thus, the Applicant fully complied with PCT Rule 17, and thereafter the U.S. Patent Office received the priority documents from the International Bureau:

Where the applicant has complied with Rule 17.1(a), (b) or (b-bis), the International Bureau shall, at the specific request of the designated Office, promptly but not prior to the international publication of the international application, furnish a copy of the priority document to that Office. *No such Office shall ask the applicant himself to furnish it with a copy.*

PCT Rule 17.2(a) (emphasis added); *see also* MPEP § 1893.03(c)(II) ("Where applicant has complied with PCT Rule 17, . . . [t]he U.S. Patent and Trademark Office, as a Designated Office, will normally request the International Bureau to furnish the copy of the certified priority document upon receipt of applicant's submission under 35 U.S.C. 371 to enter the U.S. national phase."); MPEP § 1828 (stating that the International Bureau "will normally furnish copies of the certified copy to the various designated Offices so that *the applicant will not normally be required to submit certified copies to each designated Office.*"). The examiner is invited to contact the undersigned attorney for further assistance if the U.S. Patent Office is unable to receive the copies of the priority documents from the International Bureau in accordance with PCT Rule 17.2(a) and MPEP § 1893.03(c)(II).

Specification

The Office Action alleged that the title "An Actuator" was not descriptive. The title has been amended to "A Medicine Dispensing Device." Written description support for the amended

title is found throughout the original specification, for example, at page 1, lines 6-7 and at page 2, lines 15-16. No new matter has been added. Applicant respectfully requests withdrawal of the objection to the specification.

Claim Objections

The Office Action (at page 2) objected to claim 9 because of a typographical error. Claims 9 and 35 have been amended to recite “comprising *a* pawl” instead of “comprising pawl.” Applicant specifically notes no substantive amendments have been made to any of claims. Applicant respectfully requests that the objection to claim 9 be withdrawn.

Claim Rejections – 35 U.S.C. § 112

The Office Action (at pages 2-3) rejected claims 9-22 and 35-40 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement due to the claimed pawl that is adjustable between “a reset position” and a forward position. Applicant respectfully traverses. Applicant's specification presents clear examples of a pawl that is adjustable between a reset position and a forward position, for example, at p. 5, lines 10-32 and at p. 6, lines 18-34. These examples provide an unambiguous teaching so that a “person skilled in the art can make and use the invention without undue experimentation.” MPEP § 2164.01. Indeed, the MPEP explains that:

As long as the specification discloses *at least one method for making and using the claimed invention that bears a reasonable correlation* to the entire scope of the claim, then the enablement requirement of 35 U.S.C. 112 is satisfied.

MPEP § 2164.01(b). There is no question that the Applicant's original specification more than satisfies this standard. Indeed, Applicant submits that, far from any “undue experimentation,” a skilled artisan could rely upon Applicant's teaching to make and use the claimed pawl and driven member with little or no experimentation.

Obviousness-Type Double Patenting

The Office Action (at page 3) provisionally rejected claims 9-43 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claim 38 of copending Application No. 11/522,560. Applicants respectfully traverse, for there are a number

of differences between the identified claims. Nevertheless, this issue is moot because claim 38 of the '560 application was previously cancelled.

Second, the Office Action (at page 4) provisionally rejected claims 9-43 on the grounds of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-30 of copending Application No. 11/677,706. In particular, the Office Action contends that the claims are "not patentably distinct" from each other. This contention is not correct, and Applicant respectfully traverses these rejections.

The Office Action failed to identify a number of clear differences between elements in claims 9-43 of the present Application and elements in claims 1-30 of Application No. 11/677,706. The MPEP clearly states that the Office Action must set forth *a complete § 103 analysis* (including all of "the factual inquiries set forth in *Graham v. John Deere Co.*") in order to meet its initial burden for an obviousness-type double patenting rejection. MPEP § 804(II)(B)(1). Here, the Office Action has failed to take even the first step in this requisite analysis.

Indeed, and as an illustrative example, all claims 1-30 of the 11/677,706 application includes features not specifically recited in device claim 9 of the present application, for example:

- Claim 1 – "an electrically powered actuator that *decouples from* the ratchet mechanism during the drive step";
- Claim 14 – "an actuator assembly . . . that reverses to *separate from* the movable pawl";
- Claim 25 – "wherein the electrically powered actuator is *decoupled from* the ratchet mechanism during the drive step."

Device claim 9 of the present application is clearly distinct from these claims of the 11/677,706 application. Indeed, claim 9 of the present application clearly recites that:

- a rotational motor is "*coupled to* the pawl"

Nothing in claim 9 of the present application indicates that the rotational motor necessarily "decouples from" a ratchet mechanism or "separate[s] from" a movable pawl. It should be understood that distinguishing features described above serve only as illustrative examples of the several features that differentiate the present claims from claims 1-30 of the 11/677,706 application.

If a proper analysis were performed in accordance with MPEP § 804(II)(B)(1), the Patent Office would have uncovered the numerous features that render claims 9-43 in the present application to be **clearly distinct** from claims 1-30 of copending Application No. 11/677,706. Accordingly, Applicant respectfully requests withdrawal of the obviousness-type double patenting rejections based Application No. 11/677,706.

Request for Reconsideration

Applicant submits that claims 9-43 are patentable over the prior art of record. Reconsideration and allowance is respectfully requested.

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper. The Patent Office should infer no (i) adoption of a position with respect to patentability, (ii) change in the Applicant's position with respect to any claim or subject matter of the invention, or (iii) acquiescence in any way to any position taken by the Office Action, based on the amendments made herein.

No fee is believed to be due at this time. If necessary, please apply any other charges or credits to deposit account 06-1050.

Respectfully submitted,

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